

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/720,948 Confirmation No.
5271
Appellant : Paul R. Gagnon
Filed : November 24, 2003
TC/A.U. : 3711
Examiner : Mitra Aryanpour

Docket No. : 03-482
Customer No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

REPLY BRIEF

Sir:

This is in response to the Examiner's Answer mailed June 20, 2008, setting a two month period for response, which expired on August 20, 2008,

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

*(A) Claim 1 Is Not Anticipated
By Arnold*

In rejecting claim 1 on anticipation grounds over Arnold, the Examiner relies upon *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and *Ex parte Masham*, 2 USOPQ2d 1647 (BPAI 1987) to support her position. In Appellant's opinion, both of these cases support Appellant's position that Arnold does not anticipate the subject matter of claim 1.

In *Schreiber*, the Court stated that [t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." 128 F.3d at ____, 44 USPQ2d at 1431. Claim 1 on appeal clearly calls for the sports vision training device to comprise a piece of material, which piece of material "having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual;" and "being positioned beneath the individual's eye without said piece of material covering any portion of said eye so that said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said sporting object due to said thickness while said piece of material allows said individual to look forward and up without any vision obstruction." While the Examiner may think these limitations are an intended use, they are not. Both of these limitations are structural limitations which are not met either explicitly or inherently by Arnold. Arnold is directed to an eye patch which completely covers a user's eye. It is not positioned

beneath an individual's eye without the piece of material covering any portion of the eye nor does the piece of material in Arnold allow the individual to look forward and up without any vision obstruction. The whole purpose of Arnold's device is to completely obstruct the user's vision. Still further, it is not the thickness of the piece of material which interferes with an individual's ability to look in a specific direction at a sporting object being controlled by the individual. It is the area of Arnold's piece of material covering the eye which obstructs vision.

As for the Examiner's position that Arnold's patch appears to be capable of being applied on a cheek under an eye of the user, there is no disclosure in Arnold of using his eye patch in this manner. There is absolutely no guidance in Arnold as to where to position the eye patch on a cheek of a user. Further, even if the eye patch were positioned in a location beneath the eye, there is no evidence that the thickness of Arnold's material would interfere with the individual's ability to look at a sporting object. The whole issue is nothing more than conjecture on the part of the Examiner and an anticipation rejection can not be based upon conjecture. See *In re Felton*, 484 F.2d 495, 500, 179 USPQ 295, 298 (CCPA 1973). As indicated in Appellant's Brief, on pages 11 - 13, the Examiner has failed to make any showing that Arnold's patch, when so positioned, would inherently interfere with the user's position. A mere conclusory statement, which is all the Examiner offers, is insufficient to establish inherency.

The Examiner's inherency argument also fails because as the Examiner admits on page 4, lines 4 - 6 of the

Examiner's Answer, the patch thickness disclosed by Arnold "may be the same" as Appellant's thickness. This is an admission that Arnold's thickness may not be the same as Appellant's thickness. In an inherency argument, the claimed feature must necessarily be present. Mere probabilities or possibilities are insufficient to establish an inherency argument. As stated in *In re Oelrich*, 666F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient. Thus, the Examiner has failed to establish that the claimed subject matter is inherently present.

For these reasons, claim 1 is not anticipated by Arnold and neither the *Schreiber* case nor the *Marshall* supports the Examiner's position.

*(B) Claim 10 Is Not Anticipated
By Arnold*

Claim 10 is allowable for the same reasons as claim 1. It is further allowable because Arnold does not disclose a pair of potentially disposable view restricting members. Arnold only discloses a single eye patch. This is admitted to by the Examiner when she says on page 3 of the Examiner's Answer, that "..., Arnold teaches *an eye patch* (emphasis added)"

Claim 10 also calls for each member to have an "upper edge positioned beneath the eye." It is submitted that the upper edge is a structural limitation which is not met by Arnold. In Arnold, the upper edge of the eye patch is located above the eye, not beneath it. The Examiner does not address this limitation in any of her comments.

*(C) Claims 2 and 15 Are Not
Anticipated by Arnold*

It is submitted that the Examiner has failed to show that the limitations of claims 2 and 15 are necessarily present in Arnold. In particular, the Examiner has not shown where Arnold's thickness necessarily is sufficient to direct an individual's vision up and toward the field of play and players on said field of play. For this reason, this limitation in claim 2, which is a structural limitation and not an intended use, is not anticipated by Arnold.

As for claim 15, the Examiner fails to explain where Arnold discloses vision restriction devices attached to an individual's face along side each eye to restrict the individual's peripheral vision is present in Arnold. Again, as admitted by the Examiner on page 3 of the Examiner's Answer, Arnold only discloses a single eye patch. Appellant believes that the Examiner has failed to recognize that the vision restriction devices are additional structural features of the system which are used in combination with the members positioned beneath the eyes of the user.

*(D) Claims 3 - 6, 11 - 14, 16, and 17
Are Allowable Over Arnold and
Morgan et al.*

Claims 3 - 6, 11 - 14, 16 and 17 are allowable for the reasons set forth in Appellant's Brief.

On page 12, lines 5 - 20, of the Examiner's Answer, the Examiner states argues that the argument presented by Appellant in its Brief with regard to the patentability of

claims 3 - 6, 11 - 14, 16 and 17 is speculative. Actually, the argument is anything but speculative. Arnold is directed to an eye patch to be used in a procedure where aluminum-oxide crystals are discharged from a wand onto a patient's face. There is no question that such particles could become trapped if an open-cell foamed material were to be used for the eye patch. For this reason, one of ordinary skill in the art would not make the modification proposed by the Examiner.

Still further, as argued in Appellant's Brief, an open-cell foam material would not provide the level of protection desired by Arnold. Thus, one of ordinary skill in the art would not make the proposed modification.

The Examiner has failed to rebut these arguments. No case has been made that one of ordinary skill in the art could use an open cell foam material in Arnold's eye patch and still maintain the safety desired by Arnold. For these reasons, and the reasons set forth in Appellant's Brief, claims 3, 11, and 16 are allowable.

With regard to the Examiner's comments on page 13 of the Examiner's Answer regarding claim 6, there is no disclosure in Arnold of an intermittent groove being present in an upper surface which permit momentary glances at the sports object. Both Figures 3 and 5 in Arnold are cross section views of the patches. There is no way to determine whether the depression is intermittent or not from these views. Still further, the depression is not located in an upper surface.

With regard to the Examiner's comments about claims 14 and 19 on pages 13 and 14 of the Examiner's Answer, there is no disclosure in Arnold of either the groove or the stem. Please see Appellant's previous comments about the

lack of a groove. With regard to the alleged stem in Figures 3 and 5, Appellant submits that no stem is shown in either of these figures. Once again, these figures are cross sectional views of a circular object. If one looks at Figures 2 and 4, one can see the absence of anything which can be called a stem.

With regard to claims 16 and 17 and the Examiner's comments on page 14, it is not understood how the Examiner can argue intended use. Both of these claims further define the structural features of the vision restriction devices attached to an individual's face along side each eye (claim 15). Claim 16 says that each vision restriction device comprises a first layer formed from an open cell material and a second adhesive coating or layer for adhering the vision restriction device to the individual's face. Claim 17 calls for the adhesive coating or layer to have a hydrocolloidal material. Arnold does not disclose a restriction device used in combination with the two members positioned beneath the eye and neither does Morgan et al.

*(E) Claim 18 Is Allowable Over
Micchia in view of Arnold*

The rejection made by the Examiner is purely speculation. As noted by the Examiner, the Micchia et al. device only has a thickness which appears (emphasis added) to be sufficient to interfere with the user's field of vision. Thus, there is no disclosure in Micchia, either expressly or inherently, of the claimed thickness for the material. The Examiner in making this rejection ignores this Board's previous determination that Micchia et al. does not teach or suggest the sufficient thickness limitation.

As for Arnold, it lacks any teaching of either method step set forth in claim 18. Please see Appellant's argument in his Appeal Brief on pages 19 and 20. Also see the comments herein concerning the deficiencies of Arnold's thickness teaching.

It is well settled law that an obviousness rejection may not be based on conjecture or speculation. It is submitted that the rejection made by the Examiner is deficient because it sets forth conjecture, not facts.

CONCLUSION

For the foregoing reasons, and the reasons set forth in Appellant's Brief, the Board is hereby requested to reverse the rejection of claims 1 - 22 and to remand the application back to the Primary Examiner for allowance and issuance.

FEES

No fee is believed to be due as a result of this Reply Brief. Should the Director determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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